

REMARKS

Reconsideration of the application is respectfully requested in view of the following remarks.

The Pending Claims

Claims 20-38 are pending in the application. No amendments have been made to the pending claims. Claims 1-6, 8 and 9 are directed to a photothermographic recording material comprising a support and a photo-addressable thermally developable element containing (i) a mixture of substantially light-insensitive silver salts of organic carboxylic acids, (ii) an organic reducing agent, (iii) a photosensitive silver halide, and (iv) a binder. The mixture of carboxylic acid silver salts contains a monocarboxylic acid silver salt and a dicarboxylic acid silver salt of particular formula I. Claim 7 is directed to a photothermographic recording process. Reconsideration of the pending claims is respectfully requested.

Summary of the Office Action

The Office rejects claim 20 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Further, the Office rejects claims 20, 21, 27-33, and 35-37 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,262,275 (hereinafter "Fan") in view of U.S. Patent No. 6,143,470 (hereinafter "Nguyen").

Moreover, the Office Action rejects claims 22-26 under 35 U.S.C. § 103(a) as being unpatentable over Fan in view of Nguyen further in view of U.S. Patent No. 5,888,712 (hereinafter "Lelental"). Finally, the Office rejects claims 34 and 38 under 35 U.S.C. § 103 (a) as unpatentable over Fan, in view of Nguyen, and further in view of U.S. Patent No. 4,555,471 (hereinafter "Barzynski").

Response to Objection Under 35 U.S.C. § 112, second paragraph

Applicants respectfully submit that the rejection under 35 U.S.C. § 112, second paragraph is unwarranted. In determining whether a claim is definite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1378 (Fed. Cir. 2000). If the claims "reasonably apprise" those skilled in the art of the scope of the invention, "§ 112 requires

no more." *Solomon, Id.* (emphasis added). The claims do more than merely "reasonably apprise" one of skill in the art of the scope of the claims. Quite simply, the claims only require that steps (a) through (d) (as recited in claim 20) should be performed within a period of less than 2 months. It would be well within the capabilities of a skilled artisan to calculate the time required to perform steps (a) through (d). As one of ordinary skill in the art can determine whether performing steps (a) through (d) would fall within a period of less than 2 months, the claims *do* reasonably apprise those skilled in the art as to the scope of the invention. *Solomon, supra*. Accordingly, the rejection under 35 U.S.C. § 112, second paragraph should be withdrawn.

Response to Rejection Under 35 U.S.C. § 103

Claims 20, 21, 27-33, and 35-37 were rejected under 35 U.S.C. § 103 as being unpatentable over Fan in view of Nguyen. The Office Action asserts that Fan provides for a laminated imaging material but does not teach a distinct adhesive layer between the image receiving layer and the UV-sensitive layer. The Office Action further asserts that Nguyen teaches that an adhesive material would be required when laminating an image-receiving layer to a photosensitive layer. The Office Action concludes that it would have been obvious to one of ordinary skill in the art to use an adhesive layer between the image receiving layer and the photosensitive layer as taught by Nguyen in Fan's lay-up.

Fan describes a photosensitive printing element that comprises, in order, (a) a support, (b) a photopolymerizable layer, (c) at least one barrier layer, and (d) a layer of infrared radiation sensitive material (see, e.g., col. 2, lines 55-58). Moreover, Fan describes a process for making a flexographic printing plate that comprises: (1) image-wise ablating layer (d) of the aforementioned element with infrared laser radiation to form a mask; (2) overall exposing the photosensitive element to actinic radiation through the mask; and (3) treating the product of step (2) with at least one developer solution to remove (i) infrared-sensitive material that was not removed during step (1), (ii) areas of the barrier layer that were not exposed to actinic radiation, and (iii) areas of the photopolymerizable layer (b) that were not exposed to actinic radiation (see, e.g., col. 2, lines 32-45).

The present invention, however, is not directed to a photosensitive printing element that comprises, in the following order, a support, a photopolymerizable layer, at

least one barrier, and a layer of infrared radiation sensitive material. Nor is the present invention directed to the aforementioned process. Rather, the pending claims are directed to a method for on-site preparation of a relief image comprising the following steps: (a) laminating a material comprising, in the order given, a first peelable support, an image recording layer and an adhesive layer onto a UV-sensitive material comprising a support and a UV-sensitive layer, wherein the adhesive layer is laminated to the UV-sensitive layer; (b) image-wise exposing the image recording layer to form a mask; (c) flood exposing the UV-sensitive material through the mask; (d) developing the UV-sensitive material; wherein the peelable support is removed either before step (b), (c) or (d) and wherein steps (a) to (d) are performed within a period of less than 2 months. There is simply no teaching or suggestion in Fan of laminating a material comprising, in the order given, a first peelable support, an image recording layer and an adhesive layer onto a UV-sensitive material comprising a support and a UV-sensitive layer, wherein the adhesive layer is laminated to the UV-sensitive layer; (b) image-wise exposing the image recording layer to form a mask; (c) flood exposing the UV-sensitive material through the mask; (d) developing the UV-sensitive material; wherein the peelable support is removed either before step (b), (c) or (d), much less a teaching or suggestion of such a method wherein steps (a) to (d) are performed within a period of less than 2 months, as recited in the pending claims. Nguyen fails to remedy this deficiency, by disclosing the use of an adhesive between a polymeric film and a photosensitive layer. The polymeric film is described by Nguyen as "an organic insoluble and tough polymeric film which *does not absorb UV-Visible and IR light*" (col. 8, lines 64-66) (emphasis added). Clearly, Nguyen does not teach or fairly suggest an adhesive layer between an image recording layer and an UV-sensitive layer. Accordingly, the rejection of claims 20, 21, 27-33, and 35-37 over Fan and Nguyen is considered improper, and should be withdrawn.

Similarly, the rejection of claim 20 over Nguyen in view of Fan is considered improper. As described above, Nguyen does not teach "laminating an image receiving layer and an adhesive layer onto a UV-sensitive layer on a support." Nguyen describes a coating which comprises, in order, a photosensitive aluminum substrate, a photosensitive layer, a removable adhesive layer, a polymeric film and laser ablatable top layer (col. 8, lines 44-48; and Figure 3). Specifically, Nguyen describes laminating a polymeric film to a

photosensitive layer, wherein the polymeric film *does not absorb UV-Visible or IR light* (col. 8 lines 64-66). Thus, even if Fan discloses a peelable top, the combination of Fan and Nguyen nonetheless fails to teach or fairly suggest the claimed invention. As such, Applicants respectfully request that the Office withdraw the rejection.

The secondary references (Lelenthal and Barzynski) fail to address the shortcomings described above with respect to Fan and Nguyen. Lelenthal is directed to a multilayer imaging element that includes a support, one or more image-forming layers superposed on the support, and an outermost transparent, electrically-conductive, non-charging, overcoat layer superposed on the support (see, e.g., col. 5, lines 36-41). Although Lelenthal discloses the use of imaging elements including, for example, "photographic, thermographic, electrothermographic, photothermographic, dielectric recording, dye migration, laser dye-ablation, thermal dye transfer, electrostatographic, and electrophotographic imaging elements" (see col. 12, lines 34-41, of Lelenthal), there is no teaching or suggestion of the present inventive method recited in claim 20, much less a teaching or suggestion of the embodiments of this method recited in dependent claims 22-26 (or in any of the other dependent claims for that matter).

Barzynski also does not compensate for the deficiencies of Fan. Barzynski discloses a resist film comprising a dimensionally stable base (which is transparent to actinic light in the wavelength range from 300 to 420 nm) and a mask-forming layer which is applied to the base (wherein the mask-forming layer is sensitive to heat radiation and contains a thermochromic system which, when irradiated with an IR laser having a wavelength greater than 1.00 μm , undergoes an irreversible change in its absorption spectrum in the wavelength range from 300 to 420 nm so that the optical density of the mask-forming layer in this wavelength range changes by not less than 1.3 units) (see, e.g., col. 2, lines 5-16). Moreover, Barzynski describes a process for the production of a photomask by imagewise irradiation of the resist film using an IR laser, and to a process for the production of relief images, wherein the mask-forming layer of a multilayer element comprising the resist film and a photosensitive recording material is first irradiated imagewise, using an IR laser, to form a photomask, wherein the photosensitive relief-forming layer is exposed to actinic light through the photomask, wherein the latter is removed from a photopolymeric relief-forming layer, and wherein the relief image is

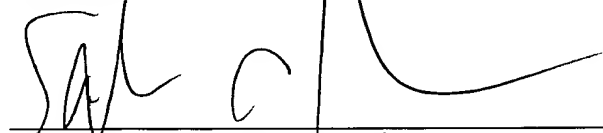
developed by washing out the relief-forming layer with a solvent (see col. 2, lines 22-33). Although Barzynski discloses that the mask-forming thermochromic layer described therein can be removed, by peeling, from a photosensitive relief layer after exposure of the latter to actinic light and before development of a relief image (see col. 7, lines 59-63), there is no teaching or suggestion of the present inventive method recited in claim 20, much less a teaching or suggestion of the embodiments of this method recited in dependent claims 34 and 38 (or any of the other dependent claims for that matter). As such, the rejections under 35 U.S.C. § 103(a) are believed improper and should be withdrawn.

Accordingly, the rejection of the pending claims over the cited art should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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